

DEC 21 2006

U.S. Patent Application No. 10/780,309  
Reply to Office Action of September 27, 2006

Docket No.: V9661.0054

**REMARKS**

Claims 1-13, 21-23, and 27-35 are pending in this case. Claims 14-20 and 24-26 have been cancelled in light of the prior Restriction Requirement. Applicants hereby confirm their election of Group I Invention recited in claims 1-13 and 21-23 but wish to clarify that the election was made without traverse. By this Amendment, applicants have amended the specification to correct typographic errors. In addition, claims 6, 9-10, 12-13, and 23 have been amended to remove informalities without narrow the scope of any of such claims or any claim element contained therein. Claim 5 has been amended to incorporate the feature in original claim 7; claim 7 has been amended in light of the amendments to claim 5. New claims 27-35 have been added, which are supported by the original specification including the claims. Applicants hereby respectfully request that the subject application be reconsidered in view of the above amendments and the following remarks.

Claim 23 has been rejected for containing informalities as stated on pages 4 and 5 of the Office action. Claim 23 as currently present in the subject application recites that the solid polymer electrolyte is a sulfonated tetrafluorethylene copolymer. Accordingly, the above rejection is believed to have been overcome.

Claims 1-10 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Kotz et al. (US Patent 4,839,007). This rejection is respectfully traversed.

Independent claims 1 and 5 each recite an electrode member comprising an antimony modified tin dioxide film coating member that contains connected particles from about 3 nm to about 5 nm in size. Kotz does not teach the above features in independent claims 1 and 5.

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The Office action acknowledges that "Kotz et al. is silent about the property of coating member comprising specific particles [size]." The Office Action then asserts that "since Kotz et al.'s product and processing making (col. 3, lines 47-64) are substantially the same as the claimed invention, Kotz et al.'s product would inherently have the same particles size," which applicants respectfully disagree.

Section 2112 of Manual of Patent Examining Procedure (MPEP) requires examiners to provide rationale or evidence tending to show inherency:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

....

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In this case, the Examiner has not met the requirements set forth in the relevant sections of MPEP. The Office action merely asserts that "Kotz et al.'s product would inherently have the same particles size." There is no proof afforded to show that the missing feature concerning the particle size is "necessarily present" in the cited portions of Kotz. MPEP § 2112.

Moreover, contrary to the assertion in the Office action, the process for making the electrode member taught in the cited portions of Kotz is not substantially the same as that of the invention. For example, Kotz uses a dipping solution having different amounts and proportions of SnCl<sub>4</sub>·5H<sub>2</sub>O and SbCl<sub>3</sub>. Kotz does not disclose the

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temperature and/or time used in the drying process. The heat-treatment in Kotz is carried out for a different period of time. As those skilled in the art will appreciate, when different dipping solution proportions and/or different heating temperature or time are used in a process, different resultant products can be obtained.

In light of the above, applicants respectfully submit that the Office action fails to establish a *prima facie* case that the missing feature concerning particle size is "necessarily present" in the cited portions of Kotz. Therefore, independent claims 1 and 5 patentably distinguish over Kotz for the above additional reason. Accordingly, the subject rejection is believed to have been overcome.

Claims 21-23 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Kotz as evidenced by Koizumi et al. (US 2004/0011665). This rejection is respectfully traversed.

Claims 21-23 each recite an electrode formed according to independent claim 1. Therefore, claim 21-23 are each allowable for at least the same reasons that claim 1 is allowable. Accordingly, the subject rejection has been overcome.

Claims 11-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kotz in regards to claim 5, and in view of Alder (US Patent 3,960,678). This rejection is respectfully traversed.

Claims 11-13 each depend from independent claim 1 directly or indirectly. Therefore, claim 11-13 are allowable for at least the same reasons that claim 1 is allowable. Accordingly, the subject rejection has been overcome.

New claims 27-35 have been added, which depend from independent claim 1 or 5 directly or indirectly. Therefore, claim 27-35 are allowable for at least the same reasons that independent claims 1 and 5 are allowable.

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Applicants have shown that claims 1-13 and 21-23 are patentable over the cited art and hereby respectfully request that the rejections of these claims be withdrawn. Each of the pending claims 1-13, 21-23, and 27-35 in this application is thus believed to be in immediate condition for allowance and such action is earnestly solicited.

Respectfully submitted,

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